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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,071	07/16/2003	Bruce Edward Stuckman	8285/628	1839

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EXAMINER	
AL AUBAIDI, RASHA S	

ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
02/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/622,071	STUCKMAN ET AL.	
	Examiner	Art Unit	
	Rasha S. AL-Aubaidi	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26-47*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1. This is in response to a pre-appeal conference decision mailed 11/30/2007.

Prosecution is re-opened.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-47 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,618,478. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in the instant application is fully disclosed in patent number 6,618,478 and it is broader than the claimed invention in the patent. No new invention or new improvement is being claimed in the instant application. Applicant is no attempting to claim broadly that which had been previously described in more detail in the claims of the patent (In re Van Ornum, 214 USPQ 761 CCPA 1982).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 26-28, 30-36, 38-44 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boakes (US PAT # 5,879,468) in view of Partridge (US PAT # 5,550,915).

Regarding claims 26, 35, 39 and 43, Boakes teaches a telephone set (10) comprising: a help key (reads on shift key 24); a first telephone service key to initiate a first telephone service (reads on the memory access key 18a); and a logic circuit (which reads on the microprocessor 14) to detect actuation of the help key and the first telephone service key, and in response thereto, to retrieve help information specific to the first service (col. 2, lines 33-50).

While Boakes does not specifically teach what is stored in memory keys, one can obviously store any desired telephone number. For Example, partridge teaches storing access codes for accessing different IXCs under different buttons 103-1 - 103-4. It would have been obvious to one of ordinary skill in the art at the time the invention was made to store any desired telephone number such as the access codes taught by Partridge under the memory keys 18 of Boakes this would make accessing IXCs more convenient and one need not remember all the numbers and access codes.

Regarding claims 27, 33, 36 and 41-44 Boakes teaches a second telephone service key to initiate a second telephone service (see col. 2, lines 43-49), wherein the

logic circuit (microprocessor 14) is to detect actuation of the help key and the second telephone service key, and in response thereto, to retrieve help information specific to the second telephone service.

Claim 32 recites "to access a telephone server having help information specific to the first telephone service". This limitation is obvious since any type of information can be stored either at a server or at the telephone itself based on the individual need and desire. Storing the information on the telephone or at the server will not rise the invention to the level of patentability.

Regarding claim 28, Boakes teaches the telephone set comprising a memory having the help information (reads on element 40, see col. 4, lines 15-18).

Regarding claim 30, Boakes teaches the telephone set comprising a plurality of telephone dialing keys including ten digit key, a pound key, and an asterisk key (see col. 3, lines 43-45).

Regarding claims 31, 38 and 46, the display device that visibly present the help information is obvious since many telephones uses the LCD display to display and confirms telephone information to the user.

For claims 34, 40 and 47, the use of and IVR is obvious. This limitation is old and well known in the art.

5. Claims 29, 37 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boakes (US PAT # 5,879,468) in view of Partridge (US PAT # 5,550,915) and further in view of Popular Mechanics (vol. 159, No. 4, April 1983, P. 199).

For claims 29, 37 and 45, the combination of Boakes and partridge does not specifically teach "an audio output device to audibly present the help information".

However, Popular Mechanics teaches a phone actually talks to you and tells the number that you pushed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of speaking up the dialed telephone number, as taught by Popular Mechanics in the combination of Boakes and Partridge system in order to serve the purpose of presenting a confirmation to the user by speaking the dialed telephone number to avoid any mistakes or confusion.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RASHA S. AL-AUBAIDI
PRIMARY EXAMINER

Art Unit 2614
02/02/2008